

## **REMARKS**

### **Status of the Claims**

Claims 1-24 and 25-27 are pending in this application and all claims were rejected by the Patent and Trademark Office ("PTO") in the March 31, 2004 Office Action. New Claim 28 is presented herein.

Claim 27 was presented in the Preliminary Amendment to the Request for Continued Examination, filed on January 16, 2004, however, the disposition of Claim 27 was not indicated in the March 31, 2004 Office Action. Further, the March 31, 2004 Office Action states that Claims 1-23, 35 and 36 are pending, whereas Applicants believe that Claims 1-24 and 25-27 are pending in this application.

Respectfully, Applicants request reconsideration of the rejected claims in view of the amendments filed herein and the following remarks.

### **Rejection of Claims 1-24, 25 and 26 under 35 U.S.C. § 103(a)**

Applicants believe the PTO intended to indicate that Claims 1-24, 25 and 26 were rejected in the March 31, 2004 Office Action as being obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 5,747,133 to *Vinod et al.* in view of U.S. Patent No. 5,932,337 to *Edinger et al.* According to the PTO (paragraph 3 of the Office Action), *Edinger et al.*<sup>1</sup> states that the particular cover layer has advantages such as the ability to be patterned, a simple manufacturing process, and enhanced mechanical properties and dirt repellent properties, and that this provides the motivation to make the proposed combination of references.

Respectfully, Applicants maintain that the premise upon which the PTO argues its 35 U.S.C. § 103 rejection does not support a *prima facie* case of obviousness for at least the

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<sup>1</sup> Paragraph 3 of the Office Action cites *Vinod et al.* for support of these stated propositions; Applicants believe the PTO intended to cite *Edinger et al.* where indicated.

following reasons: 1) *Vinod et al.* and *Edinger et al.* cannot be properly combined for lack of the requisite motivation; 2) *Vinod et al.* and *Edinger et al.* cannot be properly combined because there is no reasonable expectation of success; and 3) even if the *Vinod et al.* and *Edinger et al.* references are combined as the PTO proposes, the resulting combination would still fall short of teaching or suggesting the claimed invention.

1) Lack of Requisite Motivation. The PTO argues that *Vinod et al.* teaches selecting the fabric base in order to ensure it has sufficient strength, elongation, dimensional stability and puncture resistance (column 2, lines 15-32), and therefore it would have been obvious to have optimized the basis weight of the fabric to provide the necessary strength and stability (paragraph 4 of the Office Action). Respectfully, Applicants maintain that *Vinod et al.* does not support the proposition for which it is cited, because *Vinod et al.* specifically discloses basis weight as result effective only when the fabric base forms a separate stabilizing layer, beneath the plastic matrix.

Respectfully, Applicants assert that *Vinod et al.* clearly distinguishes between fabric base which is embedded within the plastic matrix and fabric base is adhered beneath the plastic matrix (column 2, lines 15-24). *Vinod et al.* discloses selecting the fabric base from a material that has sufficient strength, only when the fabric base is adhered beneath the plastic matrix, in which case the fabric base “*may be used to function as a stabilizing layer*” (emphasis added; column 2, lines 21-31). Specifically, *Vinod et al.* asserts:

Alternatively, in the instance wherein the fabric base is adhered beneath the plastic matrix, the fabric base may be used to function as a stabilizing layer. In this event the fabric base is selected from a material that has sufficient strength, elongation, dimensional stability and puncture resistance so as to function as a stabilizing layer.

(Emphasis added; column 2, lines 21-27.)

In evaluating obviousness, the Federal Circuit made it very clear that one must look to see if "...the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success viewed in light of the prior art." *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.*

Applicants respectfully assert that the cited art fails to provide any suggestion or motivation for optimizing the claim ranges in Applicants' invention. As noted above, both the suggestion and the expectation of success must be found in the prior art and not Applicants' disclosure. The cited art does not suggest or motivate one of ordinary skill to optimize the claimed range for non-woven material that is completely surrounded by a coating compound constituting a cover layer. Respectfully, Applicants maintain that *Vinod et al.* does not support the proposition for which it is cited, the combination of *Vinod et al.* and *Edinger et al.* that PTO proposes is therefore improper, and no *prima facie* case of obviousness has been made.

2) No Reasonable Expectation of Success. The PTO states that *Edinger et al.* provides the motivation to modify components of the cover layer of the flooring cover of *Vinod et al.* with the components of the cover layer of *Edinger et al.* Respectfully, Applicants assert that there is no motivation to combine *Vinod et al.* and *Edinger et al.* because, among other reasons, there is no reasonable expectation that the modification or combination the PTO suggests would be successful.

The PTO has stated that *Edinger et al.* describes a floor covering with a cover layer made from a combination of epoxidation products of subesters of polycarboxylic acids and polyethylene glycols. *Vinod et al.*, however, describes a fabric layer embedded within a plastic matrix (abstract), wherein the plastic matrix is formed by a plastisol that

“...comprises, at a minimum, a base resin, a plasticizer, and a stabilizer system.” (emphasis added; column 4, lines 31-33.) The stabilizer system<sup>2</sup> may include “a primary stabilizer, such as a mixture of metallo-organic salts” where it is noted that “[s]uitable for use is a mixture of organic salts and barium and zinc, such as that sold by Witco Corporation as Mark 4737.”

Respectfully, Applicants maintain that there is no reasonable expectation that the nonwoven material of *Vinod et al.* in a cover layer devoid of a stabilizer system, as *Edinger et al.* describes, would be a successful combination. Conversely, Applicants maintain that there is no reasonable expectation that the cover layer of *Edinger et al.* would be compatible with the components of the required stabilizer system of *Vinod et al.*, such as the mixture of metallo-organic salts.

As stated in the MPEP, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the references, not in Applicants’ disclosure (MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Respectfully, Applicants note that neither *Vinod et al.* nor *Edinger et al.* provide evidence of a reasonable expectation of success in the combination relied upon by the PTO.

In evaluating obviousness, the Federal Circuit made it very clear that one must look to see if “the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success viewed in light of the prior art.” *In re Dow Chemical Co. v. American Cyanamid Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Further, “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

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<sup>2</sup> The *Vinod et al.* “stabilizer system” of the plastic matrix (column 4, lines 31-33 and 41-46) is not to be confused with the “stabilizing layer” 24 (column 6, line 30-column 8, line 3) shown in Figures 1 and 2.

Respectfully, Applicants maintain that the PTO has used hindsight in combining *Vinod et al.* and *Edinger et al.* in order to pick and choose from each reference only so much of it as will support the stated position.

3) Even if Combined, the Combination Does Not Teach or Suggest the Claimed Invention. The PTO argues that *Vinod et al.* teaches employing a PVC cover or flexible layer (column 2, lines 37-42), and *Edinger et al.* teaches that its cover layer is a useful and desirable substitute for PVC layers. According to the PTO, these teachings provide motivation for combining these references and render obvious Applicants' claimed invention. Respectfully, Applicants maintain that this is an improper basis for combining *Vinod et al.* and *Edinger et al.* and, even if combined as the PTO proposes, the resulting combination still fails to teach or suggest the claimed invention.

Respectfully, Applicants assert that *Vinod et al.* does not teach employing a simple PVC cover or flexible layer as the PTO states. Rather, *Vinod et al.* (column 2, lines 37-42) discloses employing a PVC flexible layer which "may be disposed over the plastic matrix of the decorative layer" (emphasis added; column 2, lines 37-42). Therefore, even if the *Edinger et al.* cover layer is substituted for the *Vinod et al.* PVC layers as the PTO suggests, the resulting combination would still require the *Edinger et al.* cover layer made from a combination of epoxidation products of subesters of polycarboxylic acids and polyethylene glycols (column 3, lines 26-43) *disposed over* the *Vinod et al.* plastic matrix which "comprises, at a minimum, a base resin, a plasticizer, and a stabilizer system" (column 4, lines 31-33).

Accordingly, Applicants respectfully maintain that the PTO has provided an improper basis for combining *Vinod et al.* and *Edinger et al.* and, even if these references are combined as the PTO proposes, the resulting combination still falls short of teaching or suggesting Applicants' claimed invention.

For at least the reasons provided herein, Applicants respectfully assert that a *prima facie* case of obviousness have not been met. There is no suggestion or motivation to modify or combine the *Vinod et al.* and *Edinger et al.* references, nor is there a reasonable expectation of success that the modification or combination the PTO suggests would be successful. Moreover, even if combined, the *Vinod et al.* and *Edinger et al.* combination fails to teach or suggest the Applicant's invention. (MPEP §§ 706.02(j), 2143; *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Importantly, the teaching or suggestion to make the claimed combination and the reasonable expectation of success are not found in the references themselves (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143).

Therefore, Applicants respectfully maintain that none of Claims 1-24 and 25-28 is rendered obvious under 35 U.S.C. § 103(a). Accordingly, Applicants request that this rejection be withdrawn and these claims be allowed.

#### **Objection to Claims 1-23, 25 and 26**

Applicants have amended Claim 1 and 27 to read “multilayer” rather than “multiplayer.” Applicants thank the Examiner for discovering this typographical error, and respectfully request this objection be removed.

### CONCLUSION

Applicants believe the Response herein places the claims in condition for allowance and such action is respectfully requested. Applicants request an in-person interview with the Examiner at the Examiner's earliest convenience. Applicants' representative will be contacting the Examiner by telephone to see if such a meeting can be scheduled.

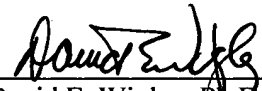
No additional fees are believed due, however, the Commissioner is hereby authorized to charge any deficiencies which may be required, or credit any overpayment, to Deposit Account Number 09-0528.

Early and favorable consideration is respectfully solicited. If the Examiner believes any informalities remain in the application that can be resolved by telephone interview, a telephone call to the undersigned attorney is requested.

Respectfully submitted,

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Date

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